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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,391	12/30/1999	CARLOS A. SILVA JR.	06975/048001	6275
26171	7590	06/27/2007	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SHINGLES, KRISTIE D	
		ART UNIT	PAPER NUMBER	
		2141		
		MAIL DATE	DELIVERY MODE	
		06/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/475,391	SILVA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kristie D. Shingles	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 April 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 36-68,70-73 and 84 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 36-68,70-73 and 84 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Response To Amendment**

Claims 36, 47, 68, 72 and 84 have been amended.  
Claims 1-35, 69 and 74-83 have been canceled.

Claims 36-68, 70-73 and 84 are pending.

### **Response To Arguments**

- I. Applicant's arguments with respect to claim 36, 47, 68 and 84 have been considered but are moot in view of the new grounds of rejection.

### **Claim Rejections - 35 USC § 112**

- II. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- III. **Claims 36, 47, 68 and 84 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The above claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The term and use of "buddy groups" in the above claims is not defined or supported by Applicant's specification. Clarification and/or correction are required.

### **Claim Rejections - 35 USC § 103**

**IV.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**V.** Claims 36-74 and 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah (US 2001/0013050) in view of DeWeese et al (US 2005/0262542).

a. **Per Claims 36 and 47,** *Shah* teach a method and a computer program disposed on a computer readable medium for providing a buddy list to a network user, the method comprising:

- accessing two or more user-defined lists of other users for whom presence is monitored, wherein each of the user-defined list comprises one or more buddy groups defined by the network user, and each of the buddy groups comprises one or more members selected by the network user, the members comprising one or more of the other users (*Figures 24 and 27, page 9 paragraph 0118, page 10 paragraphs 0122-0123, page 11 paragraph 0127; accessing multiple user-defined lists of co-users whose current availability is monitored, wherein each list comprises at least one group and at least one member selected by the user*);
- selecting an initial buddy list that includes two or more initial buddy groups from among the two or more user-defined lists (*page 10 paragraphs 0122-0124; user selects an initial buddy list by selecting a particular instant messaging service wherein each user-affiliated instant messaging service has a respective buddy list for the user*); and
- displaying the selected two or more initial buddy groups to the network user by displaying the initial buddy list to the network user on an instant messaging user interface, wherein each of the displayed two or more initial buddy groups comprises online presence information for its members (*Figures 22-27, page 10 paragraphs 0122-0123, page 11 paragraph 0127*).

Yet, *Shah* fails to explicitly teach determining television programming selected for viewing by a network user and selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming. However, *DeWeese et al* teach a television chat system allowing viewers to engage in real-time communication with other users based upon a determined television channel or program, wherein chat users may also form a buddy list or address book of other users who have the same television interests and preferences and the buddy list or address book containing groups of users interested in a particular television program, chat group, etc. (*page 6 paragraphs 0075, 0076 and 0079, page 7 paragraphs 0085-0090, page 8 paragraph 0095, page 14 paragraphs 0137-0139*). Furthermore, triggering of a chat session takes places by using a pop-up option to send a chat request to members of a particular program list/group, while the user is watching a television program (*page 7 paragraphs 0088-0090*).

It would have been obvious to one of ordinary skill in the art to combine the teachings of *Shah* with *DeWeese et al* in order to enable television-program based chatting wherein user's buddy lists are based on television programs; because just as a user may choose to chat in a particular chat room where those present are discussing a particular program, the user may also want to instant message a member in their pre-defined buddy list/group of users who also shares particular television programming interests as well; therefore allowing the user to communicate in real-time with selected co-users that are currently online for immediate discussion of the selected television programs.

b. **Claims 68 and 81-84** comprise limitations that are substantially equivalent to claims 36 and 47 are therefore rejected under the same basis.

c. **Per claims 37 and 48,** *Shah* with *DeWeese et al* teach the method and computer program of claims 36 and 47, *DeWeese et al* further teach wherein determining television programming comprises determining a television network (*Abstract, page 1 paragraphs 0010 and 0013, page 2 paragraph 0016, page 6 paragraphs 0075-0076*).

d. **Per claims 38 and 49,** *Shah* with *DeWeese et al* teach the method and computer program of claims 36 and 47, *DeWeese et al* further teach wherein determining television programming comprises determining a television show (*Abstract, page 1 paragraphs 0010 and 0013, page 2 paragraph 0016, page 6 paragraphs 0075-0076*).

e. **Per claims 39 and 50,** *Shah* with *DeWeese et al* teach the method and computer program of claims 36 and 47, *DeWeese et al* further teach wherein determining television programming comprises determining a characteristic of a television show (*page 6 paragraphs 0075-0076, page 7 paragraphs 0087-0088*).

f. **Per claims 40 and 51,** *Shah* with *DeWeese et al* teach the method and computer program products of claims 39 and 50, *DeWeese et al* further teach wherein determining a characteristic comprises determining a type of the television show (*page 6 paragraphs 0075-0076, page 7 paragraphs 0087-0088*).

g. **Per claim 41,** *Shah* with *DeWeese et al* teach the method of claim 40, *DeWeese et al* further teaches the method wherein the type comprises sports (*page 6 paragraphs 0075-0076*).

h. **Per claim 42,** *Shah* with *DeWeese et al* teach the method of claim 41, *DeWeese et al* further teach the method of claim 41 wherein determining television programming comprises determining a sports team (*page 7 paragraph 0088*).

i. **Per claims 43 and 52,** *Shah* with *DeWeese et al* teach the method of claim 36 and 47, *DeWeese et al* further teach the method and computer program further comprising receiving information indicating a change in the television programming viewed by the network user; selecting a different chat room based upon the changed television programming (page 11 paragraphs 0116-0121, page 12 paragraphs 0123 and 0129).

j. **Per claims 44 and 53,** *Shah* with *DeWeese et al* teach the method of claim 36 and 47, *Shah* further teaches wherein the different buddy list differs from the initial buddy list (page 10 paragraphs 0122-0124; *DeWeese et al*—page 7 paragraphs 0085-0090, page 8 paragraph 0095, page 11 paragraphs 0116-0118, page 14 paragraphs 0137-0139).

k. **Per claims 45 and 54,** *Shah* with *DeWeese et al* teach the method of claim 36 and 47, *DeWeese et al* further teach wherein at least one member of the different buddy list differs from the members of the initial buddy list (page 7 paragraphs 0085-0090, page 14 paragraphs 0137-0139; *Shah*: page 10 paragraphs 0122-0124). It would have been obvious to one of ordinary skill in the art to combine the teachings of *Shah* with *DeWeese et al* for allowing the user to define multiple buddy lists with different user, because this allows the user to specify a specific purpose, theme, or use for multiple buddy lists, wherein members of a specific buddy list share and discuss a common interest; in this case, the user's different buddy list and members refer to different television programs.

l. **Per claims 46 and 55,** *Shah* with *DeWeese et al* teach the method of claim 36 and 47, *DeWeese et al* further teach wherein the members of the different buddy list differs from the members of the initial buddy list (page 7 paragraphs 0085-0090, page 11 paragraphs 0116-0118, page 14 paragraphs 0137-0139; *Shah*—page 10 paragraphs 0122-0124).

Art Unit: 2141

m. **Per claims 56, 62 and 69,** *Shah* with *DeWeese et al* teach the method and computer program product of claims 36, 47 and 68, *Shah* further teaches receiving user definition of a first buddy list and a second buddy list (*Figures 24 and 27, page 9 paragraph 0118, page 10 paragraphs 0122-0124, page 11 paragraph 0127; DeWeese et al—page 7 paragraphs 0087-0089, page 14 paragraphs 0137-0139*).

n. **Per claims 57 and 63,** *Shah* with *DeWeese et al* teach the method and computer program of claims 56 and 62, *Shah* further teaches wherein selecting an initial buddy list comprises selecting an initial buddy list from among the first buddy list and the second buddy list (*page 10 paragraphs 0122-0123; DeWeese et al—page 7 paragraphs 0087-0089, page 14 paragraphs 0137-0139*).

o. **Claims 58 and 64** are substantially equivalent to claims 43-46 and are therefore rejected under the same basis.

p. **Claims 59 and 65** are substantially equivalent to claim 43 and are therefore rejected under the same basis.

q. **Claims 60 and 66** are substantially equivalent to claim 43 and are therefore rejected under the same basis.

r. **Claims 61 and 67** are substantially equivalent to claim 45 and are therefore rejected under the same basis.

s. **Claims 70-74** are substantially equivalent to claims 43-46 and are therefore rejected under the same basis.

## Conclusion

Art Unit: 2141

**VI.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Belzer et al (5905493), Bruck et al (7143428), Trovato et al (6425012).

**VII.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**VIII.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie D. Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday 8:00am-5:30pm.

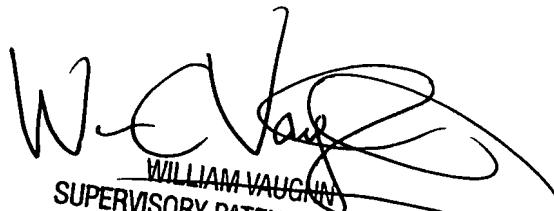
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kristie D Shingles*  
*Examiner*  
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*kds*



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